

Application No. 10/803,107
Amendment dated May 14, 2007
Reply to Office action of January 13, 2007

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3. Remarks

Rejections under 35 USC §102

The Examiner has rejected **Claims 1-5, 9-12, and 16-20** under 35 USC §102 as being anticipated by **Smith, U.S. Pat. No. 6,663,129**. Essentially, with respect to **Claim 1**, the Examiner states that Smith discloses all elements of the current invention except for the shim, which is well-known in the art. Applicant admits that shims, by themselves, are "well-known." However, Applicant submits that having a shim adapted for placement on a shift lever, "between the cooperating portion of the motorcycle shift arm and at least one of the wing portions" is not well-known in the art, particularly when the use of the shim is planned so as to allow a selective modification of the position of the shift tip. Applicant has amended the claims to clarify that the distance between the "wing portions" is intentionally made large enough to require the use of the shim, thus allowing selective positioning of the shift tip, which is clearly not shown in any of the art cited by the Examiner.

Further, with respect to **Claims 2-4** the Examiner does not appear to consider that it is not just the use of multiple shims that is claimed. Rather, the claim includes features of construction of the shift lever, in particular, the wing portion, that allows for selective, particular placement of the shims to achieve the particular result desired – a modifiable positioning of the shift tip.

Claims 9 through 11 have been cancelled and their limitations of holes in the wing portions and a slanting member connecting the wing portions to the second end of the shift tip have been added to **Claim 5**. Further, the claim has been modified to clarify that the holes are the portion of the fastening assembly that is offset from the central axis defined by the knob portion and that the holes can be seen as offset in the same direction and distance from the defined central axis. The Examiner has stated that Figure 2 of **Smith** shows a slanted member connecting wing portions to the second end of the shift

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tip. However, Applicant respectfully asserts that Figure 2 of **Smith** fails to show or suggest a slanted member that effects the offset of the holes in the same direction from the central axis, as claimed; thus, **Claim 5**, as amended, as well as dependent **Claims 6-8**, are allowable.

With respect to **Claim 12**, the Examiner asserts that Figure 2 of **Smith** shows the fastener assembly offset a selected distance from the central axis. However, although each of the wing portions of the fastener assembly of Figure 2 on **Smith** is "offset" to each side of a central axis, as a whole, the fastener assembly is not shown as offset. Rather, it appears to be symmetric about the axis. Thus, the claim is allowable over the cited art. Applicant has also requested that the claim be amended to correct duplicative language that was inadvertently included in the original claim, and clarify that the use of the slanted member accomplishes the offset.

Claim 16 is cancelled and its features added to **Claim 12**.

Claim 17 has been amended to clarify that the offset of the central point of the holes is to the same side of the central axis – that it is not symmetric. This feature is not shown or suggested by **Smith**.

Claim 18 is cancelled.

Claims 19 and 20 have been amended to clarify that the distance between the "wing portions" is intentionally made large enough to require the use of the shim, thus allowing selective positioning of the shift tip, which is clearly not shown in any of the art cited by the Examiner. Thus, these claims are allowable for the same reasons as set forth with respect to **Claim 1**. Further **Claim 20** has been amended to clarify that the distance between the "wing portions" is intentionally made large enough to require the use of the shim, thus allowing selective positioning of the shift tip, which is clearly not shown in any of the art cited by the Examiner.

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Rejections under 35 USC §103

The Examiner has rejected claims **Claims 6-8 and 13-15** under 35 USC §103 as being unpatentable over **Smith**. The Examiner states that **Claims 6-8 and 13-15** are unpatentable on the grounds that discovering the "workable distance" claimed was only a matter of "routine skill" in the art. However, each of these claims depends from what Applicant maintains is an allowable claim, and is allowable on that basis alone. In addition, while it might be true that *if Smith* taught an offset as claimed, the mere selection of distance would not be of patentable significance, any offset that is taught by **Smith** is symmetric and thus there would not be any apparent advantage in the selecting a particular offset. For this reason, **Smith** cannot make the selection of the offsets claimed obvious. Thus, the limitations of particular selected distances are of patentable significance and **Claims 6-8 and 13-15** are allowable.

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4. Conclusion

Applicant respectfully requests allowance of all remaining claims.

Respectfully submitted,

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